Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	Atty. Docket
Darwin HE, et al.	NL 020795US
	Confirmation No. 1795
Serial No. 10/525,138	Group Art Unit: 2434
Filed: February 16, 2005	Examiner: SANDERS, Stephan
Title: COMMUNICATION SYSTEM AND METHOD BETWEEN A RECORDING AND/OR REPRODUCING DEVICE AND A REMOTE UNIT	

Mail Stop Appeal Brief-Patents
Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

Appellants herewith respectfully present a Brief on Appeal as follows, having filed a

Notice of Appeal on September 17, 2010:

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

REAL PARTY IN INTEREST

The real party in interest in this appeal is the assignee of record Koninklijke Philips Electronics N.V., a corporation of The Netherlands having an office and a place of business at Groenewoudseweg 1, Eindhoven, Netherlands 5621 BA.

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

RELATED APPEALS AND INTERFERENCES

Appellants and the undersigned attorney are not aware of any other appeals or

interferences which will directly affect or be directly affected by or having a bearing on the

Board's decision in the pending appeal.

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

STATUS OF CLAIMS

Claims 1-2, 4-6, 8-15, 18 and 20-25 are pending in this application, where claims 3, 7, 16-17 and 19 are canceled. Claims 1-2, 4-6, 8-15, 18 and 20-25 and are rejected in the Final Office Action mailed on June 18, 2010. This rejection was upheld in an Advisory Action mailed on September 8, 2010. Claims 1-2, 4-6, 8-15, 18 and 20-25 are the subject of this appeal.

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

.

STATUS OF AMENDMENTS

Appellants filed on August 17, 2010 an after final amendment in response to a Final Office Action mailed June 18, 2010. The after final amendment included amendments to claim 6. In an Advisory Action mailed on September 8, 2010, it is indicated that the after final amendment filed on August 17, 2010 will be entered, and overcomes the rejection and objection to claims 6, 14-15 and 24, but does not place the application in condition for allowance. This Appeal Brief is in response to the Final Office Action mailed June 18, 2010, that finally rejected claims 1-2, 4-6, 8-15, 18 and 20-25, which remain finally rejected in the Advisory Action mailed on September 8, 2010.

5

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention, for example, as recited in independent claim 1, shown in

FIGs 1-2, and described on page 1, line 28 to page 2, line 17, and page 3, lines 3-32 of the

specification, is directed to a communication method via a network 30 between a device 20

able to read a memory medium 22, and a remote unit 10 comprising additional data 11 for

the memory medium 22. As described on page 4, line 33 to page 6, line 10 of the

specification, the communication method comprises extracting memory medium properties

23 from the memory medium 22 inserted in the device 20, sending the memory medium

properties 23 to the remote unit 10, authenticating the memory medium 22 by comparing

the memory medium properties 23 with corresponding properties of a corresponding

memory medium legally produced by a provider, before sending the additional data 11 to

the device 20, and determining that the memory medium 22 is illegally produced when the

memory medium properties 23 are different from the corresponding properties even if the

memory medium 22 includes identical content for rendering as the corresponding memory

medium. As described on page 6, liens 1-7, the memory medium properties 23 include a

region code of the memory medium 22.

The present invention, for example, as recited in independent claim 5, shown in

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

FIGs 1-2, and described on page 1, line 28 to page 2, line 17, and page 3, lines 3-32 of the specification, is directed to a communication system comprising a device 20 able to read a memory medium 22, and a remote unit 10 comprising additional data 11 for the memory medium 22. As described on page 4, line 33 to page 6, line 10 of the specification, the device 20 and the remote unit 10 communicate via a network 30, where the remote unit 10 is able to retrieve memory medium properties 23 from the memory medium 22 inserted in the device 20, to authenticate the memory medium 22 by comparing the memory medium properties 23 with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data 11 to the device 20, and to determine that the memory medium 22 is illegally produced when the memory medium properties 23 are different from the corresponding properties even if the memory medium 22 includes identical content for rendering as the corresponding memory medium. As described on page 6, liens 1-7, the memory medium properties 23 include a region code of the memory medium 22.

The present invention, for example, as recited in independent claim 6, shown in FIGs 1-2, and described on page 1, line 28 to page 2, line 17, and page 3, lines 3-32 of the specification, is directed to a remote unit 10 for communicating with a device 20 able to read a memory medium 22. As described on page 4, line 33 to page 6, line 10 of the

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

specification, the remote unit 10 comprising additional data 11 for the memory medium 22,

a processor configured to retrieve memory medium properties 23 from the memory medium

22 inserted in the device 20, to authenticate the memory medium 23 by comparing the

memory medium properties 23 with corresponding properties of a corresponding memory

medium legally produced by a provider, before sending the additional data 11 to the device

20, and to determine that the memory medium 23 is illegally produced when the memory

medium properties 23 are different from the corresponding properties even if the memory

medium 22 includes identical content for rendering as the corresponding memory medium.

As described on page 6, liens 1-7, the memory medium properties 23 include a region code

of the memory medium 22.

The present invention, for example, as recited in independent claim 8, shown in

FIGs 1-2, and described on page 1, line 28 to page 2, line 17, and page 3, lines 3-32 of the

specification, is directed to a computer readable medium embodying a computer program

comprising program instructions for implementing, when the program is executed by a

processor, a communication method via a network 30 between a device 20 able to read a

memory medium 22, and a remote unit 10 comprising additional data 11 for the memory

medium 22.   As described on page 4, line 33 to page 6, line 10 of the specification, the

communication method comprises extracting memory medium properties 23 from the

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

memory medium 22 inserted in the device 20, sending the memory medium properties 23

to the remote unit 10, and determining that the memory medium 22 is illegally produced

when the memory medium properties 23 are different from corresponding properties of a

corresponding memory medium legally produced by a provider even if the memory medium

22 includes identical content for rendering as the corresponding memory medium. As

described on page 6, liens 1-7, the memory medium properties 23 include a region code of

the memory medium 22.

The present invention, for example, as recited in independent claim 9, shown in

FIGs 1-2, and described on page 1, line 28 to page 2, line 17, and page 3, lines 3-32 of the

specification, is directed to a computer readable medium embodying a computer program

comprising program instructions for implementing, when the program is executed by a

processor, a communication method via a network 30 between a device 20 able to read a

memory medium 22, and a remote unit 10 comprising additional data 11 for the memory

medium 22. As described on page 4, line 33 to page 6, line 10 of the specification, the

communication method comprises retrieving memory medium properties 23 from the

memory medium 22 inserted in the device 20, authenticating the memory medium 22 by

comparing the memory medium properties 23 with corresponding properties of a

corresponding memory medium legally produced by a provider, before sending the

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

additional data 11 to the device 20, and determining that the memory medium 22 is illegally

produced when the memory medium properties 23 are different from the corresponding

properties even if the memory medium 22 includes identical content for rendering as the

corresponding memory medium. As described on page 6, liens 1-7, the memory medium

properties 23 include a region code of the memory medium 22.

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-2, 4-6, 8-15 and 20-25 of U.S. Patent Application Serial No. 10/525,138 are unpatentable under 35 U.S.C. §103(a) over WO 01/90860 (Schwartz) in view of U.S. Patent No. 6,405,203 (Collart).

Whether claim 18 of U.S. Patent Application Serial No. 10/525,138 is unpatentable under 35 U.S.C. §103(a) over Schwartz in view of Collart and U.S. Patent Application Publication No. 2003/0110192 (Valente).

11

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

ARGUMENT

<u>Claims 1-2, 4-6, 8-15 and 20-25 are said to be unpatentable under 35 U.S.C.
§103(a) over Schwartz in view of Collart.</u>

Appellants respectfully request the Board to address the patentability of independent

claims 1, 5-6 and 8-9, and further claims 2, 4, 10-15, 18 and 20-25 as depending from

claims 1, 5-6 and 8-9, based on the requirements of independent claims 1, 5-6 and 8-9.

This position is provided for the specific and stated purpose of simplifying the current

issues on appeal. However, Appellants herein specifically reserve the right to argue and

address the patentability of claims 2, 4, 10-15, 18 and 20-25 at a later date should the

separately patentable subject matter of claims 2, 4, 10-15, 18 and 20-25 later become an

issue. Accordingly, this limitation of the subject matter presented for appeal herein,

specifically limited to discussions of the patentability of claims 1, 5-6 and 8-9 is not intended

as a waiver of Appellants' right to argue the patentability of the further claims and claim

elements at that later time.

Schwartz is directed to a method for authenticating that a specified pre-recorded

media (e.g., CD) is inserted into a drive for granting access to restricted content related to a

specific prerecorded media. As recited on page 2, lines 10-17, the Schwartz method

authenticates a CD by "<u>generating a unique identifier</u> from the contents." (Schwartz, page

2, line 12; emphasis added) The "unique identifier [is passed] to a verification script on the

Internet." (Schwartz, page 5, line 10) A <u>bonus track is downloaded</u> to the user's computer

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

if "the <u>unique identifier</u> that is sent from the user's computer <u>matches</u> the identifier of the audio CD that is qualified for the download (Schwartz, page 5, line 21-22; emphasis added)

As correctly noted on page 5, last paragraph of the Final Office Action, Schwartz does not disclose or suggest that "the memory medium properties include a region code of the memory medium," as recited in independent claims 1, 5-6 and 8-9. Collart is cited in an attempt to remedy the deficiencies in Schwartz.

Collart is directed to a method for preventing unauthorized users from using the content of an electronic storage medium, where distribution of content is electronically **tracked**. As shown in FIG 2 and described on column 19, lines 7-25, information collected by a RemoteTrak/BCATrak Server 230 is used to track pirated DVDs, and report the information back to the manufacturer, the distributor and the retailer. This capability provides the ability to <u>localize</u> pirated discs to a specific region/retailer where illegal region code use is <u>tracked</u> and potentially <u>trace back</u> to retailer/distributor.

It is respectfully submitted that Schwartz, Collart, and combination thereof do not disclose or suggest the present invention as recited in independent claim 1, and similarly recited in independent claims 5-6 and 8-9 which, amongst other patentable elements, recites (illustrative emphasis provided):

> authenticating the memory medium **by comparing** said <u>memory medium properties</u> with corresponding properties of a corresponding memory medium legally produced by a provider, <u>before sending the additional data to the device</u>,...
> wherein the <u>memory medium properties include</u> a **region code** of the memory medium.

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

Authenticating a memory medium using a region code, namely, **by comparing** the **region code** (of the memory medium) **itself** with a corresponding region code of a corresponding memory medium legally produced by a provider, before sending the additional data to the device is nowhere disclosed or suggested in Schwartz and Collart, alone or in combination. Rather, in Collart, region codes are used to track pirated DVDs and trace the back to a retailer/distributor.

At best, the combination of Schwartz and Collart discloses or suggests using the Collart region code to track and localize pirated discs, or using the Collart region code to generate the Schwartz unique identifier for comparison and match in order to allow download of a bonus track. **Comparing** the memory medium **region code itself** to provide **authentication** before sending additional data is nowhere disclosed or suggested in Schwartz, Collart, and combination thereof. Rather, the unique Schwartz **unique identifier is compared**, and not the region code itself, where this unique Schwartz unique identifier is generated using the Collart region code.

In the Advisory Action of September 8, 2010, it is correctly noted that Collart discloses region codes. However, it is alleged that Collart also discloses "usefulness [of a region code] in determining the memory medium's authenticity." This allegation is respectfully traversed. In particular, as discussed above, Collart uses the region code to localize pirated discs to a specific region/retailer. That is, the region code is used to track and potentially trace back to retailer/distributor. It is respectfully submitted that using region

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

codes to track and trace back pirated discs to retailer/distributor does not disclose or suggest using the region code to authenticate the memory medium. Even if Collart is capable of using the region code to authenticate the memory medium, the fact remains that Collart does not disclose or suggest any such use for the regions code. Instead of using region code to authenticate the memory medium, Collart merely describes using the region code to track and trace back pirated discs to retailer/distributor.

Whether or not a prior art reference is capable of performing the recitations of the claims is not a proper part of an obviousness analysis. Otherwise, for example, any processor, which is 'capable' to perform any function if programmed to do so, may be deemed prior art to a particular processor which is specifically configured to perform a specific function recited in a claim.

Further, even assuming, arguendo, that somehow the combination of Schwartz and Collart discloses or suggests using the Collart region code to authenticating the memory medium, which it does not, there is still no disclosure or suggestion in Schwartz and Collart, alone or in combination, of authenticating the memory medium by comparing the memory medium properties that include the region code of the memory medium with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to the device, as recited in independent claims 1, 5-6 and 8-9.

Accordingly, it is respectfully requested that independent claims 1, 5-6 and 8-9 be allowed. In addition, it is respectfully submitted that claims 2, 4, 10-15 and 20-25 should

15

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

also be allowed at least based on their dependence from independent claims 1 and 5-6 as well as their individually patentable elements.

Claim 18 is said to be unpatentable under 35 U.S.C. §103(a) over Schwartz in view of Collart and Valente.

It is respectfully submitted that claim 18 should be allowed at least based on its dependence indirectly from independent claim 1.

In addition, Appellants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, Appellants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

CONCLUSION

Claims 1-2, 4-6, 8-15, 18 and 20-25 are patentable over Schwartz, Collart and Valente.

Thus, the Examiner's rejections of claims 11-2, 4-6, 8-15, 18 and 20-25 should be reversed.

Respectfully submitted,

By_____
Dicran Halajian, Reg. 39,703
Attorney for Appellants
October 27, 2010

THORNE & HALAJIAN, LLP
111 West Main Street
Bay Shore, NY 11706
Tel: (631) 665-5139
Fax: (631) 665-5101

Please direct all inquiries and correspondence to:
Michael E. Belk, Reg. 33,357
Philips Intellectual Property & Standards
P.O. Box 3001
Briarcliff Manor, NY 10510-8001
(914) 333-9643

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

CLAIMS APPENDIX

1.(Previously Presented) A communication method via a network between a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said communication method comprising the acts of:

extracting memory medium properties from the memory medium inserted in the device,

sending said memory medium properties to the remote unit,

authenticating the memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to the device, and

determining that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory medium includes identical content for rendering as the corresponding memory medium, wherein the memory medium properties include a region code of the memory medium.

2.(Previously Presented) The communication method as claimed in claim 1, wherein the memory medium properties are written in a control data zone of the memory medium.

Claim 3 (Canceled)

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

4.(Previously Presented) The communication method as claimed in claim 1, wherein the remote unit is able to send different types of additional data as a function of the memory medium properties.

5.(Previously Presented) A communication system comprising a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said device and the remote unit communicating via a network, wherein the remote unit is able to retrieve memory medium properties from the memory medium inserted in the device, to authenticate said memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to said device, and to determine that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory medium includes identical content for rendering as the corresponding memory medium, wherein the memory medium properties include a region code of the memory medium.

6.(Previously Presented) A remote unit for communicating with a device able to read a memory medium, the remote unit comprising additional data for the memory medium; and a processor configured to retrieve memory medium properties from the

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

memory medium inserted in the device, authenticate said memory medium by comparing

said memory medium properties with corresponding properties of a corresponding memory

medium legally produced by a provider, before sending the additional data to said device,

and determine that the memory medium is illegally produced when the memory medium

properties are different from the corresponding properties even if the memory medium

includes identical content for rendering as the corresponding memory medium, wherein the

memory medium properties include a region code of the memory medium.

Claim 7 (Canceled)

8.(Previously Presented) A computer readable medium embodying a computer

program comprising program instructions for implementing, when said program is executed

by a processor, a communication method via a network between a device able to read a

memory medium, and a remote unit comprising additional data for the memory medium,

said communication method comprising the acts of:

extracting memory medium properties from the memory medium inserted in the

device,

sending said memory medium properties to the remote unit, and determining that the

memory medium is illegally produced when the memory medium properties are different

from corresponding properties of a corresponding memory medium legally produced by a

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

provider even if the memory medium includes identical content for rendering as the

corresponding memory medium, wherein the memory medium properties include a region

code of the memory medium.

9.(Previously Presented) A computer readable medium embodying a computer

program comprising program instructions for implementing, when said program is executed

by a processor, a communication method via a network between a device able to read a

memory medium, and a remote unit comprising additional data for the memory medium,

said communication method comprising the acts of:

retrieving memory medium properties from the memory medium inserted in the

device,

authenticating the memory medium by comparing said memory medium properties

with corresponding properties of a corresponding memory medium legally produced by a

provider, before sending the additional data to the device, and determining that the memory

medium is illegally produced when the memory medium properties are different from the

corresponding properties even if the memory medium includes identical content for

rendering as the corresponding memory medium, wherein the memory medium properties

include a region code of the memory medium.

10.(Previously Presented) The communication method of claim 1, wherein the

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

memory medium comprises at least one read-only, recordable, and rewritable discs.

11.(Previously Presented) The communication method of claim 1, wherein the

memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs.

12.(Previously Presented) The communication system of claim 5, wherein the

memory medium comprises at least one read-only, recordable, and rewritable discs.

13.(Previously Presented) The communication system of claim 5, wherein the

memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs.

14.(Previously Presented) The remote unit of claim 6, wherein the memory medium

comprises at least one read-only, recordable, and rewritable discs.

15.(Previously Presented) The remote unit of claim 6, wherein the memory medium

comprises at least one of a DVD, CD, DVD, and Blu-ray discs.

Claims 16-17 (Canceled)

18.(Previously Presented) The communication method of claim 1, further

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

comprising the act of blacklisting the device if the remote unit receives a number of

requests higher than a predetermined threshold from the device containing a non-

authenticated memory medium.

Claim 19 (Canceled)

20.(Previously Presented) The communication method of claim 1, wherein the

additional data includes advertisement depending on the region code.

21.(Previously Presented) The communication method of claim 1, further

comprising the act of allowing recording of the additional data if the authenticating act is

successful.

22.(Previously Presented) The communication method of claim 1, further

comprising the act of allowing access to the additional data only while the memory medium

is being played in the device.

23.(Previously Presented) The communication system of claim 5, wherein the

additional data includes advertisement depending on the region code.

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

24.(Previously Presented) The remote unit of claim 6, wherein the additional data includes advertisement depending on the region code.

25.(Previously Presented) The communication system of claim 5, wherein the region code is stored in a secondly content provider information of a control data zone of a lead-in area of the memory medium; the control data zone further including physical format information; the physical format information including book type, disc size, disc structure, and burst cutting area descriptor; wherein the disc structure includes a number of layers of the disc, a layer type and a track path, and the secondly content provider information further include copyright information.

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

EVIDENCE APPENDIX

None

Patent
Serial No. 10/525,138
Appeal Brief in Reply to the Final Office Action of June 18, 2010
and the Advisory Action of September 8, 2010

RELATED PROCEEDINGS APPENDIX

None